

REMARKS

STATUS OF THE CLAIMS

In accordance with the foregoing, no claims have been amended. Claims 1 and 3-9 are pending and under consideration.

No new matter is being presented, and reconsideration of the claims is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1, 3, 5, and 7-9 are rejected under 35 U.S.C. § 103(a) as being anticipated by Brown et al. (U.S. Patent 6,073,137) (hereinafter "Brown") in view of Yeung et al. (U.S. 2003/0093556) (hereinafter "Yeung"). The rejections of claims 1, 3, 5, and 7-9 are respectfully traversed and reconsideration is requested.

On page 3 of the Action, the Examiner notes that Brown does not disclose a file system that reads documents by use of a scanner and files the documents on the basis of the obtained information, as recited in independent claim 1, for example. Thus, Yeung is cited as disclosing these features.

Brown discusses a file management method between mail software (an e-mail client application program 37 and a mail server 49). (See Brown, 6: 25-32). Further, Brown discloses that the local version of the folder configuration is created in "Microsoft Outlook," which provides a system of organizing messages. (See Brown, 5:1-9). Meanwhile, Yeung discusses a file system that reads documents, by use of a scanner, and files them.

The mail file management of Brown and the scanner file system of Yeung relate to different technical fields. In Brown, retrieved data is used to synchronize folders so that the displayed list of folders matches the list from the server. (See Brown, 5:1-9). In Yeung, as the Examiner suggests, after documents are scanned, the image file is then stored in a scanned document folder 1008 by the MFP controller 1004. (See Yeung, paragraph [0124]).

Therefore, Brown and Yeung are inappropriately combined in order to reject the features of the independent claims, discussed above. Independent claims 1 and 7-9 recite creating *the same folder configuration* in a file system that reads documents by use of a scanner and files the documents on the basis of the obtained information.

Accordingly, an advantage of the embodiments of the present invention is to enable automatic creation of *filing folders*, without requiring a user to create filing folders, before an operation of reading paper information (documents) by use of a scanner and filing them. (As support, see for example paragraph [0005] of the present application).

As commonly understood, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art... "[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992). In addition, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Id. at 1783-84. Applicants also note, "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). (See MPEP §2143.01).

Thus, accordingly, a prima facie obviousness rejection requires evidence of motivation from some reference in the record that would have led one skilled in the art to combine the relevant teachings, again noting that the mere fact that the prior art may be modified in a particular manner does not make the modification obvious unless the prior art suggested the desirability of that modification.

In this case, one of ordinary skill in the art would have had no suggestion or motivation to combine Yeung with Brown. Since the system of Yeung is merely capable of scanning a document and placing it in a *predetermined* folder, there is no motivation for combining the teachings of Yeung with the mail file management system of Brown which retrieves data and synchronizes folders so that the displayed list of folders matches the list from the server.

Therefore, it is respectfully submitted that the combination of references cited by the Examiner is inappropriate. Independent claims 1, 7 and 8 patentably distinguish over Brown, and Yeung fails to cure the deficiencies of Brown discussed above. Thus, it is further submitted that independent claims 1, 7 and 8 patentably distinguish over the prior art. Consequently, it is further submitted that dependent claim 3 also patentably distinguish over the prior art, for at least the reasons provided above for the independent claims.

In the Office Action, at item 4, claim 4 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Brown in view of Yeung and further in view of Sykes (US Pre-Grant Publication 2002/0129108). The rejection is traversed and reconsideration is requested.

Claim 4 depends from independent claim 1, which as stated above patentably distinguishes over the prior art. Further, it is submitted that Sykes fails to cure the deficiencies of Hendricks and Yeung set forth above. Therefore, it is respectfully submitted that dependent claim 4 patentably distinguishes over the prior art for the reasons provided herein.

In the Office Action, at item 5, claim 6 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Brown in view of Yeung and further in view of Hendricks (US Pre-Grant Publication 2003/0033271). The rejection is traversed and reconsideration is requested.

Claim 6 depends from independent claim 1, which as stated above patentably distinguishes over the prior art. Further, it is submitted that Hendricks fails to cure the deficiencies of Brown and Yeung set forth above. Therefore, it is respectfully submitted that dependent claim 6 patentably distinguishes over the prior art for the reasons provided herein.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims patentably distinguish over the prior art. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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